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| CMC Interconnect Technologies, Inc.; |) | No. MC-09-0003-PHX-DGC |
| Third Dimension Semiconductor, Inc.; |) | |
| Great Wall Semiconductor Corp.; Icmos |) | ORDER |
| Technology Corp.; and Samuel |) | |
| Anderson, an individual, |) | |
| |) | |
| Movants, |) | |
| |) | |
| vs. |) | |
| |) | |
| Fairchild Semiconductor Corp., |) | |
| |) | |
| Respondent. |) | |
| |) | |
| |) | |

Movants seek to quash a subpoena that Fairchild Semiconductor Corp. (“Fairchild”) served on CMC Interconnect Technologies, Inc. (“CMC”). Dkt #1. A response, a reply, and a motion for leave to file a sur-reply have been filed. Dkt. ##7, 10, 24. For the following reasons, the Court will transfer this issue to the United States District Court for the District of Maine.

I. Background.

Fairchild and Third Dimension Semiconductor, Inc. (“3D”) are litigating a dispute over their patent licensing agreement before the United States District Court for the District of Maine. *See Fairchild Semiconductor Corp. v. Third Dimension (3D) Semiconductor Corp.*, Civ. No. 08-158-DBH (D. Me., filed May 15, 2008). Fairchild seeks a declaratory

1 judgment that it is complying with the agreement and an injunction against 3D's cancellation
2 of the agreement in response to an alleged breach by Fairchild. Dkt. ##1 at 2; 7 at 1-2. 3D
3 argues that Fairchild has breached the agreement by failing to pay royalties for the sale of
4 several products incorporating 3D's patented designs. *Id.*

5 Prior to the litigation, the CEO and President of 3D, Samuel Anderson, contracted
6 with CMC, an engineering laboratory located in Tempe, Arizona, to analyze Fairchild
7 product FCP11N60 to determine if it incorporated 3D's patented semiconductor designs.
8 Dkt. ##1 at 8; 1-2 at 2; 11 at ¶ 3; 12 at 2. Mr. Anderson submitted approximately five
9 samples of that product to CMC on behalf of 3D in January, 2008, and CMC sent him a
10 Secondary Ion Mass Spectrometry ("SIMS") report by the end of the month. Dkt. ##1-2 at
11 10; 7 at 2; 11 at ¶ 3-5; 12 at 2; 25 at 2. 3D continued to receive CMC's analytical services
12 as Fairchild and 3D moved toward litigating their dispute over the licensing agreement.
13 Dkt. ##11,12 at ¶¶ 8-9.

14 3D showed the one-page CMC SIMS report to Fairchild during pre-suit negotiations.
15 As a result, a Maine federal magistrate judge ordered that 3D produce that page during
16 discovery. Dkt. ##1 at 3; 7 at 3. As discovery continued, 3D produced several other SIMS
17 reports from laboratories other than CMC. Dkt. #13 at ¶¶ 4-5.

18 At a November 5, 2008 evidentiary hearing on Fairchild's motion for a preliminary
19 injunction, Mr. Anderson testified to the similarities between Fairchild's products and 3D's
20 patents in technical detail, relying in part on CMC's SIMS report. Dkt. ##7 at 2; 13-4 at 4.
21 Counsel for Fairchild directed Mr. Anderson's attention to that report on cross examination.
22 Dkt. #13-4 at 6. Mr. Anderson stated that he had sent several samples of Fairchild's product
23 to CMC for analysis. *Id.* at 7. Counsel for Fairchild asked Mr. Anderson if CMC had
24 prepared separate SIMS reports for each sample. *Id.* at 9-10. Mr. Anderson explained that
25 the single SIMS report covered all of the Fairchild product samples – he had sent CMC
26 multiple samples in case "they broke" one. *See id.* at 9-10. But in an attempt to clarify the
27 precise number of SIMS reports and Fairchild products associated with CMC's analysis, Mr.
28 Anderson (as well as counsel for both Fairchild and 3D) appears to have confused CMC's

1 SIMS report with SIMS reports from different laboratories. *See* Dkt. ##8-2 at 3-5; 10 at 3;
2 13-4 at 9-13. Accordingly, Fairchild resolved to discover the character and extent of CMC's
3 analysis for 3D. *See, e.g.*, Dkt. #8-2 at 3-5.

4 On December 30, 2008, Fairchild served CMC with a Rule 45 subpoena demanding
5 production of (1) all documents concerning CMC's SIMS report, (2) all documents
6 concerning any testing or analysis of Fairchild products for Movants, and (3) all
7 communications between CMC and Movants, or their respective attorneys, regarding
8 Fairchild products. *See* Dkt. #1-2 at 6-7. Movants ask the Court to quash the subpoena
9 because it seeks information protected both by the work product doctrine and Rule 26(b)(4)
10 of the Federal Rules of Civil Procedure. Dkt. #1 at 3-5. Fairchild contends that the work
11 product doctrine does not shield CMC's information from discovery, and that 3D voluntarily
12 waived any applicable Rule 26(b)(4) protection by disclosing CMC's SIMS report in pre-trial
13 negotiations and by using it in Anderson's testimony at the preliminary injunction hearing.
14 Dkt. #7 at 5, 7. Fairchild contends that the scope of 3D's waiver embraces all subject matter
15 relating to CMC's analysis of any Fairchild products. *Id.* at 7-10.

16 **II. Discussion.**

17 This dispute clearly should be resolved by the court presiding over the Maine
18 litigation. The dispute concerns the discoverability of information relevant to that lawsuit.
19 It concerns a waiver alleged to have occurred during the preliminary injunction hearing in
20 that lawsuit. Indeed, the parties' briefs quote excerpts from the hearing transcript and cite
21 frequently to the docket in the Maine lawsuit. *See, e.g.*, Dkt. #7 at 2-4. What is more, a
22 federal magistrate judge in Maine has issued at least one discovery ruling on the SIMS
23 report. *Id.*

24 Rule 45 normally calls for the court that issued a subpoena to resolve disputes arising
25 from the subpoena. *See* Fed. R. Civ. P. 45(c)(1), (c)(3)(A), (c)(3)(B). This presumably is
26 because the recipient of the subpoena often will not be a party to the underlying litigation and
27 often will not be subject to the jurisdiction of the court presiding over that litigation. In this
28 case, however, the motion to quash concerns a dispute between Fairchild and 3D, parties to

1 the Maine lawsuit. CMC may be the recipient of the subpoena and one of the Movants in this
2 Court, but the work product, privilege, and waiver issues raised in the motion all belong to
3 3D and Fairchild. The Maine court has jurisdiction over Fairchild and 3D, and 3D ultimately
4 controls all of the documents Fairchild seeks to obtain through the subpoena.¹

5 Federal courts have held that a court issuing a subpoena may transfer a dispute
6 concerning that subpoena to the court presiding over the litigation, if circumstances warrant.
7 *See Melder v. State Farm Mutual Auto Ins. Co.*, No. 1:08-CV-1274-RWS-JFK, 2008 WL
8 1899569 (N.D. Ga., April 25, 2008) (discussing cases). The Court concludes that transfer
9 of this motion is warranted because of (1) the Maine court's familiarity with the complex
10 underlying patent litigation; (2) the potential impact of this discovery dispute on that
11 litigation; (3) the Maine court's familiarity with the specific events alleged to have produced
12 a waiver, some of which occurred before the presiding district judge; (4) the Maine
13 magistrate judge's prior ruling on a closely-related discovery issue; and (5) the fact that the
14 Maine court has before it the key parties and lawyers involved in the dispute. The Court will
15 therefore order that the motion to quash be transferred to the Maine court for decision.

16 **IT IS ORDERED:**

- 17 1. The motion to quash (Dkt. #1), including Respondent's motion for leave to file
18 sur-reply (Dkt. #24), is transferred to the United States District Court for the
19 District of Maine for resolution.

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25 ¹The subpoena includes documents obtained from CMC by Samuel Anderson, the
26 President of 3D, and Great Wall Semiconductor, allegedly an Anderson-related entity.
27 Fairchild has made clear in its response, however, that it seeks these documents only to the
28 extent that Anderson or Great Wall were acting on behalf of 3D. Dkt. #7 at 11 & n. 4. This
portion of the subpoena, therefore, is also limited to the Fairchild-3D disagreement and is
best addressed by the court presiding over the Fairchild-3D litigation.

DATED this 4th day of March, 2009.

Daniel G. Campbell

David G. Campbell
United States District Judge